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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,329	02/17/2004	Jeff Grady	4185-101-CIP2	1103

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW  
PO BOX 14329  
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER
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VO, NGUYEN THANH

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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01/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/780,329	GRADY, JEFF	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nguyen.Vo	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-11,14-24,27 and 30-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-11,14-24,27 and 30-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 9-11, 14-18, 22-24, 27, 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell (US 2004/0224638 A1, cited by applicant) in view of Qureshey (US 2002/0002039 A1, cited by examiner) and Tse Chun Hin (US 2005/0047071, cited by examiner).

As to claim 1, Fadell discloses an audio player assembly (see figures 2, 12) comprising (a) an MP3 player (see the MP3 player at paragraph [0043]); and (b) an audio player unit comprising at least one speaker (see figure 12), and a modular docking unit having a main body portion with a docking cavity therein for docking said MP3 player (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]), wherein said audio player unit is operatively connected with the MP3 player for receiving an audio signal produced by the MP3 player and for outputting a corresponding audible signal through the at least one speaker (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]). Fadell thus discloses all of the claimed limitations except (i) an FM receiver operatively coupleable with the speaker; and (ii) the modular docking unit further comprises any of a frequency indicator on the main body portion and a frequency tuning control on the main body portion.

With respect to the claimed limitation (i), Fadell does disclose at paragraph [0058] that the media devices 154 of figures 2 and 12 comprise audio equipment. Qureshey discloses an audio equipment (see "audio device system" at paragraphs [0018], [0020]) which comprise a FM radio receiver adapted to receive audio-containing radio signals transmitted from FM radio stations (see paragraphs [0011], [0080], [0088]). The FM radio receiver comprises a frequency indicator 1230 and a frequency tuning control (see paragraphs [0134]-[0137]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Qureshey to Fadell such that the audio equipment in figure 12 of Fadell comprises a FM radio receiver, in order to allow the users to enjoy FM audio signals broadcasted from FM radio stations (as suggested by Qureshey).

With respect to the claimed limitation (ii), Tse Chun Hin discloses an audio player assembly (see figure 3) having a modular docking unit 20 for docking a MP3 player 19, wherein the modular docking unit 20 comprises a frequency tuning control 23 on a main body portion (see paragraph [0026]; figure 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Tse Chun Hin to Fadell such that the frequency tuning control is located in the modular docking unit shown in figure 12 of Fadell, in order to allow the user to easily select the tuning frequency of the FM radio receiver, and to save spaces for other control buttons of the boom box.

As to claim 17, it is rejected for similar reasons as set forth in claim 1 above.

As to claims 3, 18, see Fadell, figures 4A-4B, 7E, 12-13.

As to claims 9, 22, 41, 48, see Fadell, paragraph [0074].

As to claims 10, 23, Fadell discloses fire-wire coupling as claimed (see paragraph [0004]).

As to claims 11, 24, 38, 49, the modified Fadell further discloses an amplifier 222 coupled with the speaker for outputting the amplified audio signal through the speaker as claimed (see Qureshey, figure 2).

As to claims 14, 27, see Fadell, figures 4A, 4B, 12.

As to claims 15, 30, 39, 50, see Fadell, paragraph [0043].

As to claims 16, 31, see Fadell, paragraph [0058].

As to claims 32, 34, 42, 44, the modified Fadell fails to disclose a digital frequency indicator as claimed (see Qureshey, figure 18B).

As to claims 33, 43, the modified Fadell discloses a frequency tuning control as claimed (see Qureshey, paragraphs [0134]-[0137]).

As to claims 35, 45, Fadell discloses a plurality of speakers as claimed (see figure 12).

As to claims 36, 46, Fadell discloses a battery 224 as claimed (see figure 5; paragraph [0074]).

As to claims 37, 47, Fadell discloses AC interface element as claimed (see figure 5; paragraph [0060]).

As to claims 40, 51, Fadell discloses USB coupling as claimed (see paragraphs [0004], [0074]).

3. Claims 4-5, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell in view of Qureshey and Tse Chun Hin, and further in view of Shealtiel (US 2002/0106993, cited by examiner).

As to claims 4-5, 19-20, the modified Fadell fails to disclose that the docking unit comprises at least one indicator light indicative of the operational state of the unit as claimed. Shealtiel discloses a docking unit 312 (see figures 6-7) comprising at least one indicator light indicative of the operational state of the unit (see paragraph [0076]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Shealtiel to the modified Fadell, in order to allow the user to visualize the operational state of the unit (as suggested by Shealtiel at paragraph [0076]).

4. Claims 6, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell in view of Qureshey and Tse Chun Hin and Shealtiel as applied to claims 4 and 19 above, and further in view of Dimenstein (US 2002/0086703, cited by examiner).

As to claims 6, 21, the modified Fadell fails to disclose that the indicator light indicates the charging status of a battery in the MP3 player docked in the docking cavity of the docking unit as claimed. Dimenstein discloses an indicator light 118 indicating the charging status of a battery in a communication device 109 docked in the docking cavity of a docking unit 100 (see paragraph [0035]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Dimenstein to the modified Fadell, in order to allow the user to visualize the charging state of the battery (as suggested by Dimenstein at paragraph [0035]).

5. Claims 52-60, 62-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell (US 2004/0224638 A1, cited by applicant) in view of Qureshey (US 2002/0002039 A1, cited by examiner).

As to claim 52, Fadell discloses an audio player (see figure 12; see also the boom box at paragraph [0058]) adapted for use with a portable digital media player having a storage medium adapted to receive and store digital media files (see the MP3 player at paragraph [0043]), the audio player comprising a main body portion having a docking cavity adapted to receive said portable digital media player (see figure 12), wherein the docking cavity includes therein an electrical coupling element adapted to engage the portable digital media player when the portable digital media player is received by the docking cavity (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]); and at least one speaker 376 (see figure 12) associated with the main body portion and selectively operable with the portable digital media player when received by the docking cavity, to output audible signals (see paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107]). Fadell thus discloses all the claimed limitations except an FM receiver adapted to receive audio-containing radio signals from radio stations, and the FM receiver having an associated frequency indicator and a frequency tuning control disposed on the main body portion as claimed.

However, Fadell does disclose at paragraph [0058] that the media devices 154 of figures 2 and 12 comprise audio equipment. Qureshey discloses an audio equipment (see "audio device system" at paragraphs [0018], [0020]) which comprise a FM radio receiver adapted to receive audio-containing radio signals transmitted from FM radio

Art Unit: 2618

stations (see paragraphs [0011], [0080], [0088]). The FM radio receiver has a main body portion comprising a frequency indicator and a frequency tuning control (see figures 13A-13B; paragraphs [0134]-[0137]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Qureshey to Fadell such that the audio equipment in figure 12 of Fadell comprises a FM radio receiver, in order to allow the users to enjoy FM audio signals broadcasted from FM radio stations (as suggested by Qureshey).

As to claim 53, Fadell discloses the MP3 player at paragraph [0043].

As to claim 54, see Fadell, paragraphs [0007], [0074], [0081], [0088], [0091], [0096], [0107].

As to claims 55-57, 60, 64-65, see Fadell, paragraph [0074].

As to claim 58, the combination of Fadell and Qureshey discloses the claimed limitations (see Qureshey, figure 18B).

As to claim 59, the combination of Fadell and Qureshey discloses the claimed limitations (see Qureshey, figures 13A-13B, paragraphs [0134]-[0137]).

As to claim 62, see Fadell, paragraphs [0060], [0063], [0095].

As to claim 63, the combination of Fadell and Qureshey discloses an amplifier as claimed (see Qureshey, paragraph [0137]).

As to claim 66, Fadell discloses a plurality of speakers 376 (see figure 12).

As to claim 67, Fadell discloses a boom box as claimed (see paragraph [0058]).

As to claim 68, it is rejected for similar reasons as set forth in claim 52.



Art Unit: 2618

6. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fadell in view of Qureshey as applied to claim 52 above, and further in view of Dimenstein (US 2002/0086703, cited by examiner).

As to claim 61, the modified Fadell fails to disclose that the indicator light indicates the charging status of a battery in the MP3 player docked in the docking cavity of the docking unit as claimed. Dimenstein discloses an indicator light 118 indicating the charging status of a battery in a communication device 109 docked in the docking cavity of a docking unit 100 (see paragraph [0035]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Dimenstein to the modified Fadell, in order to allow the user to visualize the charging state of the battery (as suggested by Dimenstein at paragraph [0035]).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 3-6, 9-11, 14-24, 27, 30-68 have been considered but are moot in view of the new ground(s) of rejection.

#### **Objection to the Specification under 35 USC 132(a):**

The examiner finds applicant's arguments persuasive. Accordingly, the objection to the specification under 35 USC 132(a) is withdrawn.

#### **Rejections to Claims 1, 17 and Claims Depending Therefrom Over the Cited Art:**

Applicant's attention is directed to the new ground of rejection to claims 1, 17 over Fadell (US 2004/0224638 A1) in view of Qureshey (US 2002/0002039) and Tse Chun Hin (US 2005/0047071) as set forth above for the reasons as to why claims 1, 17 and claims depending therefrom are not allowed over the cited prior art.

Rejections to Claim 52 and Claims Depending Therefrom Over the Cited Art:

Applicant argues that Fadell fails to specifically disclose the audio equipment in figure 12 including a FM radio receiver. The examiner agrees. However, Qureshey is relied on for the teaching of a FM radio receiver included in an audio equipment. Accordingly, the combination of Fadell and Qureshey would clearly result an audio equipment in figure 12 (of Fadell) which further includes a FM radio receiver.

Applicant further argues that there is no motivation to combine Qureshey with Fadell because the audio equipment in figure 12 of Fadell has no FM radio receiver. The examiner, however, disagrees. Fadell and Qureshey both disclose audio equipments. For that reason, providing a FM radio receiver in an audio equipment of Qureshey to another audio equipment of Fadell is proper.

Discussion of Secondary Consideration Evidence:

The examiner, in the advisory action mailed on 01/11/2007, has considered applicant's secondary consideration evidence.

***Commercial Success***

The commercial success provided by applicant is not found persuasive to overcome the finding of obviousness for the following reasons. Applicant fails to show that the commercial success directly derived from the invention claimed, "in a marketplace wherein the consumer is free to choose on the basis of objective principles" and it must be shown "that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed

invention." MPEP 716.03(b). Accordingly, the applicant bears the burden of supporting the contention of nonobviousness by establishing a nexus between the claimed invention and evidence of commercial success. Also, the evidence provided must be commensurate in scope with the claims. Additionally, gross sales figures do not show commercial success absent evidence as to market share, or the time period during which the product was sold, or the normally expected sales in the market.

In response, applicant argues that Netalog sold more than 85,000 units of IBOOM boombox within two years, and that provides ample evidence of the "time period during which the product as sold". The examiner, however, disagrees. The gross sales figures do not show commercial success absent evidence **as to what sales would normally be expected in the market**, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

Applicant further argues that the IBOOM boombox had a 100% market share for products within the scope of the present patent claims at the time the IBOOM boombox was introduced because Mr. Grady was unaware of any other product embodying the features of the pending patent claims. The examiner, however, disagrees. First of all, merely stating that Mr. Grady was unaware of any other product embodying the features of the pending patent claims is insufficient to demonstrate a 100% market share. Second, most of the nineteen (19) other products were also on the market within the past two years. It is not clear as to how the IBOOM boombox had a 100% market share within the past two years while most of the nineteen (19) other products were also on the market.

In addition, the commercial success must be commensurate in scope with the claims. The IBOOM boom box does not have a FM radio receiver as recited in claims 1, 17 and 52. The IBOOM boom box does not have a frequency tuning control and a frequency indicator located in the modular docking unit as recited in claims 1 and 17.

In addition, applicant fails to show that the commercial success directly derived from the invention claimed, **"in a marketplace wherein the consumer is free to choose on the basis of objective principles"** and it must be shown **"that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention."**

### ***Copying***

Applicant's secondary evidence that the IBOOM boombox product was copied by others is not persuasive for following reasons. First of all, applicant admits that "Applicant has no direct evidence (e.g., testimony or other admissions) that third parties have copied Applicant's IBOOM boombox". Second, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead. *Dow Chem. Co. v. American Cyanamid Co.*, >816

Art Unit: 2618

F.2d 617<, 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

***Commercial Success by third parties***

The examiner's comments in the "Commercial Success" section as set forth above are herein incorporated.

In addition, it is believed that Commercial Success by Third Parties is not an evidence of secondary considerations. It is not found in section 716 of the M.P.E.P.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DE 102 17 365 C 1 discloses a radio receiver 3 with docking unit for MP3 player 1 (see figure 1).

White (US 7,187,947) discloses an audio system 500 with docking unit 501 for MP3 player 502 (see figure 5A).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen Vo whose telephone number is (571) 272-7901. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nguyen Vo  
Primary Examiner  
Art Unit 2618

*Nguyen Vo*  
1-14-2008